



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,904	12/01/2000	Bjorn Markus Jakobsson	38-2	3689

7590 05/28/2003

Joseph B. Ryan
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER

BAYAT, BRADLEY B

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,904

Applicant(s)

JAKOBSSON ET AL.

Examiner

Bradley Bayat

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/1/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of: _____
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishioka et al. (U.S. Patent 5,754,656) in view of Kyojima et al. (U.S. Patent 6,275,936 B1).

As per claims 1-4 and 7-15, Nishioka discloses an electronic authenticating shopping method and system wherein selective information relating to a purchase request by a user is only known to a merchant and certain authentication information is obtained by a payment center (see column 2, lines 33-67; columns 3-7 and accompanying figures). Nishioka does not explicitly teach the use of a blinded ciphertext technique. Kyojima teaches a method to control access to digital data by applying a blind effect to a ciphertext and the use of a blind decryption method and access right authentication (see column 4, lines 57-67; columns 5-6 and 7-14 and accompanying figures). Kyojima is evidence that one of ordinary skill in the art would recognize the benefit of utilizing a blind ciphertext decryption method to accomplish access control and authentication to digital data without disclosing unnecessary purchase information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention to utilize such techniques to accomplish the above stated purpose, as per teachings of Kyojima.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishioka and Kyojima as applied to claim 1 above, and further in view of Zheng, U.S. Patent 6,396,928 B1.

As per claims 5 and 6, Nishioka and Kyojima do not explicitly teach the use of an ElGamal encryption technique or the Schnorr signature scheme. Zheng teaches a method and system for performing digital message encryption and signature coding for use in communications and digital information systems, including ElGamal and Schnorr signature and encryption schemes or any suitable encryption algorithm, such as DES or the like (see column 2, lines 14-23; column 4, line 40 – column 5, line 67). Zheng is evidence that one of ordinary skill in the art would recognize the benefit of utilizing such techniques for secure authentication communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention to utilize such techniques to accomplish the above stated purpose, as per teachings of Zheng.

Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishioka et al. (U.S. Patent 5,754,656) in view of Kyojima et al. (U.S. Patent 6,275,936 B1).

As per claims 16-20, Nishioka discloses an electronic authenticating shopping method and system wherein selective information relating to a purchase request by a user is only known to a merchant and certain authentication information is obtained by a payment center (see column 2, lines 33-67; columns 3-7 and accompanying figures). Nishioka does not explicitly teach the use of a blinded ciphertext technique. Kyojima teaches a method to control access to digital data by applying a blind effect to a ciphertext and the use of a blind decryption method and access right authentication (see column 4, lines 57-67; columns 5-6 and 7-14 and

accompanying figures). Kyojima is evidence that one of ordinary skill in the art would recognize the benefit of utilizing a blind ciphertext decryption method to accomplish access control and authentication to digital data without disclosing unnecessary purchase information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention to utilize such techniques to accomplish the above stated purpose, as per teachings of Kyojima.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Patent No. 5,715,314 to Payne et al., Network Sales System.

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached Tuesday – Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the

Application/Control Number: 09/727,904

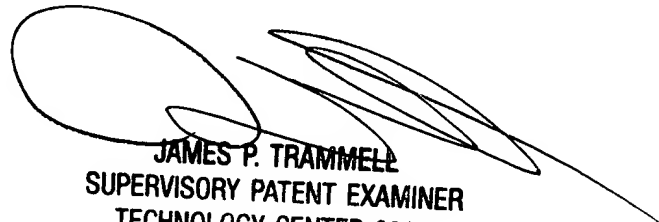
Page 5

Art Unit: 3621

organization where this application or proceeding is assigned are 703-746-6128 for regular communications and 703-746-6128 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
May 21, 2003



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600